

## **REMARKS**

### **Administrative Overview**

Claims 1–12, 19, 20, 23, and 24 were elected for prosecution in this case. In the Office Action mailed on February 27, 2009, claims 1–12 were rejected under 35 U.S.C. § 112, ¶ 1 as failing to comply with the enablement requirement, and under 35 U.S.C. § 112, ¶ 2 as being indefinite for failing to claim the subject matter regarded as the invention. Claims 1–8, 19 and 23 were rejected under 35 U.S.C. § 103 over U.S. Patent No. 6,385,594 (hereinafter “Lebda”). Claims 9–12, 20 and 24 were objected to as being dependent upon a rejected base claim, but were said to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### **Rejection of Claims 1–12 under 35 U.S.C. § 112, ¶ 1**

Claims 1–12 were rejected under 35 U.S.C. § 112, ¶ 1 as failing to comply with the enablement requirement. In particular, the claims are said to be a “single means” claim which are unduly broad. *In re Hyatt* (708 F.2d 712, 714–15) is cited as authority for this rejection.

*In re Hyatt* concerned the following claim:

35. A Fourier transform processor for generating Fourier transformed incremental output signals in response to incremental input signals, said Fourier transform processor comprising incremental means for incrementally generating the Fourier transformed incremental output signals in response to the incremental input signals.

See Ex. A at ¶ 3 (emphasis added). The opinion in *In re Hyatt* makes clear that claim 35 was a “single means” claim because it literally recited a single means, i.e., not in combination with other elements. See, e.g., Ex. A, at ¶ 14.

In contrast, claims 1–4, 9 and 10 concern a plurality of means elements in combination. Claims 5–8, 11 and 12 are method claims that do not recite any means elements. Accordingly, we submit that this rejection is clear error and respectfully request its withdrawal.

### **Rejection of Claims 1–12 under 35 U.S.C. § 112, ¶ 2**

Claims 1–12 were rejected under 35 U.S.C. § 112, ¶ 2 as being indefinite for failing to claim the subject matter regarded as the invention. In particular:

“the word ‘means’ is preceded by the words ‘for receiving’, ‘for saving’, ‘for selectively’, in an attempt to use a ‘means’ clause to recite a claim element as a

means for performing a specified function. However, since no function is specified by the word(s) preceding 'means,' it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph."

*Ex parte Klumb* (159 USPQ 694) is cited as authority for this rejection.

As a threshold matter, claims 5–8, 11 and 12 are method claims that do not recite any means elements. The rejection of these claims under 35 U.S.C. § 112, ¶ 2 is clear error and we request its withdrawal.

As to claims 1–4, 9 and 10, the rejection is unclear. The form language in the rejection comes from MPEP 706.03(d), specifically ¶ 7.34.11, "Modifier of 'Means' Lacks Function." However, as the rejection makes clear, it concerns language preceding 'means' that specifies no function. There is no language in any of claims 1–4, 9 and 10 preceding any of the 'means' elements. Moreover, all of the language that follows the 'means' elements in those claims specifies a function.

Accordingly, this rejection should either be withdrawn or clarified.

Rejection of Claims 1–8, 19 and 23 under 35 U.S.C. § 103 over Lebda

Claims 1–8, 19 and 23 were rejected under 35 U.S.C. § 103 as being unpatentable over Lebda. Lebda bears an issue date of May 7, 2002, and a filing date of May 8, 1998. Nothing in Lebda claims any priority date earlier than May 8, 1998.

The present application was filed on August 27, 2003. It is a divisional of U.S. Patent Application No. 10/441,534, filed on May 20, 2003, which itself is a divisional of U.S. Patent Application No. 08/526,776, filed on September 12, 1995 (now issued as U.S. Patent No. 5,878,403). The foregoing amendments amend the specification to make this priority claim explicit, and a Petition to Accept an Unintentionally Delayed Priority Claim has been filed with the Office of Petitions as of the date of this response.

As this case is entitled to a priority date of September 12, 1995, Lebda is not prior art to this application. We respectfully request the withdrawal of this rejection.

**CONCLUSION**

In light of the foregoing, we respectfully submit that all of the pending claims are in condition for allowance. Accordingly, we respectfully request reconsideration, withdrawal of all grounds of rejection and objections, and allowance of all of the pending claims in due course.

If the Examiner believes that a telephone conversation with the Applicant's attorney would be helpful in expediting the allowance of this application, the Examiner is invited to call the undersigned at the number identified below.

Respectfully submitted,

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